

REMARKS

Claims 3 and 11 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. This rejection is overcome by the amendments to claims 1, 3, 8 and 11 clearly defining each computer system and the function thereof. Therefore, this rejection is overcome in view of the amendment to claim 1.

Claims 1-2, 7-8, 10 and 15 are rejected under 35 U.S.C. §102(e) as being anticipated by *Jain* (U.S. Patent 6,480,853). Applicants traverse this rejection on the grounds that this reference is defective in supporting a rejection under 35 U.S.C. §102.

Independent Claims 1 and 8 include: "a user inputting a search term into the user computer system that specifies any websites associated with the bookmarks to be searched; the search engine receiving the search term and accessing the bookmarks to obtain identifiers for the websites associated with the bookmarks and providing search results to the user computer system; and the user computer system displaying the search results."

The PTO provides in MPEP §2131..."To anticipate a claim, the reference must teach every element of the claim...". Therefore, to sustain this rejection *Jain* must contain all of the claimed elements of independent claims 1 and 8. However, the interactions of the first, second and user computer systems, as claimed, are not shown or taught in *Jain*. Therefore, the rejection is unsupported by the art and should be withdrawn.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Therefore, independent claims 1 and 8 and their respective dependent claims are not anticipated by the admitted prior art reference.

Claims 3-4, 11 and 14 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Jain* in view of *Himmell et al.* (U.S. 6,324,566).

Applicants traverse these rejections on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

As the PTO recognizes in MPEP § 2142:

...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness....the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'"

The combined references fail to teach or suggest the claimed method and system as defined in the claims as amended for the reasons set forth above and as further defined in the dependent claims.

Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection because neither reference teaches or even suggests the desirability of the combination. Moreover, neither reference provides any incentive or motivation supporting the desirability of the combination. For example, the interaction of the first and second systems with the search engine, bookmarks, search term and identifiers along with the identifier and search term information being provided to the search engine, and search results provided to an identified computer system is not disclosed or suggested, see the specification at page 5, lines 4-16.

The MPEP §2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Therefore, the Examiner's combination arises solely from hindsight based on the invention without any showing of suggestion, incentive or motivation in either reference for the combination.

Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met.

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The Federal Circuit has, on many occasions, held that there was no basis for combining references to support a 35 U.S.C. §103 rejection. For example, in *In re Geiger*, the court stated in holding that the PTO "failed to establish a *prima facie* case of obviousness":

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Federal Circuit has also repeatedly warned against using the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1798, 1792 (Fed. Cir. 1989).

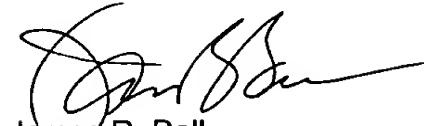
More recently, the Federal Circuit found motivation absent in *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, the court concluded that the

board had “reversibly erred in determining that one of [ordinary] skill in the art would have been motivated to combine these references in a manner that rendered the claimed invention [to have been] obvious.” The court noted that to “prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.” The court further noted that there were three possible sources for such motivation, namely “(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art.” Here, according to the court, the board had relied simply upon “the high level of skill in the art to provide the necessary motivation,” without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Notably, the court wrote: “If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance.”

Therefore, independent claims 1 and 8 and the claims dependent therefrom are submitted to be allowable.

In view of the above, it is respectfully submitted that claims 1-4, 7, 8, 10, 11, 14 and 15 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,



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